



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/553,183 | 07/21/2006 | Matthias Fies | C 2684 PCT/US | 2216 |
| 23657 | 7590 | 11/01/2010 | | |
| FOX ROTHSCHILD LLP 997 Lenox Drive, Bldg. #3 Lawrenceville, NJ 08648 | | | | |
| EXAMINER | | | | |
| CAMERON, ERMA C | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1715 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 11/01/2010 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@foxrothschild.com

Office Action Summary

Application No.

10/553,183

Applicant(s)

FIES ET AL.

Examiner

/Erma Cameron/

Art Unit

1715

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-16 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-16 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11-13, 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kigawa et al (5798434).

'434 teaches a dimer diol with acrylic or methacrylic (see Abstract; 2:48-60; 3:28-34), as a coating substance (13:50-14:13). These dimer diols of carboxylic acids inherently have a flattening property. As part of a coating system (3:65-14:13), any number of substrates may be used, but glass is disclosed as one substrate (12:30-40). The claimed degree of esterification appears to be met.

Response to Arguments

The applicant has argued that the examiner has cited no reference regarding the flattening properties of dimerdiol (meth)acrylates. The examiner's rational is that the same composition is used by '434 as is used by applicant, and that therefore the composition of '434 inherently possesses the property of flattening. See MPEP 2112 II ("...There is no requirement that a person ...would have recognized the inherent disclosure...") or MPEP 2112 III ("...a rejection under

35 USC 102/103 can be made when the prior art product seems to be identical except that the prior art is silent as to an inherent characteristic...”).

3. Claims 11-16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dershem et al (6121358).

‘358 teaches a coating material or encapsulant (3:1-53) that comprises a diacrylate of dimer diol (6:1-20) as well as fillers such as silicon dioxide (13:24-37). Both the dimer diol acrylate and the filler would inherently have flattening properties. The claimed degree of esterification appears to be met. The substrate may be an inorganic material, such as glass (claim 22; 14:66-15:11; 1:55-62).

Response to Arguments

The applicant has argued that the examiner has cited no reference regarding the flattening properties of dimerdiol (meth)acrylates. The examiner’s rational is that the same composition is used by ‘358 as is used by applicant, and that therefore the composition of ‘358 inherently possesses the property of flattening. See MPEP 2112 II (“...There is no requirement that a person ...would have recognized the inherent disclosure...”) or MPEP 2112 III (“...a rejection under 35 USC 102/103 can be made when the prior art product seems to be identical except that the prior art is silent as to an inherent characteristic...”).

The applicant has also argued that the glass cloth of ‘358 is somehow different from the glass claimed in claims 11 and 19. The examiner disagrees. The broadest interpretation of “glass” encompasses various physical forms, such as glass cloth or glass fibres.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- 5, The rejection of Claims 11 and 19 are rejected under 35 U.S.C. 112, first paragraph, is withdrawn because of the amendment filed 9/24/2010.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Erma Cameron/ whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Erma Cameron/
Primary Examiner
Art Unit 1715

October 25, 2010